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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GUY A. STORY, JR.,  
ROZSA E. KOVESDI,  
AJIT V. RAJASEKHARAN, and  
BENJAMIN CHE-MING JUN

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Appeal 2010-006618  
Application 09/222,336  
Technology Center 3600

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Before HUBERT C. LORIN, ANTON W. FETTING, and  
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Guy A. Story, Jr., et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-8, 10-18, and 20-33. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We REVERSE.<sup>1</sup>

## THE INVENTION

Claim, reproduced below, is illustrative of the subject matter on appeal.

1. A method comprising:

creating a first license comprising a first cardinality, wherein a cardinality indicates the number of playback devices that can be authorized for playback of associated digital audio content, the license created by and the cardinality to be enforced by a license management device;

transmitting information corresponding to the first license to a content provider from the license management device;

transmitting the first license to a first set of playback devices from the license management device, wherein the first set of playback devices is less than or equal to the first cardinality;

storing the first license in the first set of playback devices in response to a command from the license management device; and

determining whether playback of first digital audio content received from the content provider is authorized by comparing the first license with the first digital audio content having one or more embedded licenses by the first set of playback devices.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Aug. 20, 2008) and Reply Brief ("Reply Br.," filed Jan. 6, 2009), and the Examiner's Answer ("Answer," mailed Nov. 7, 2008).

Katz

US 5,926,624

Jul. 20, 1999

The following rejections are before us for review:

1. Claims 1-8, 10-18, and 20-33 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1-8, 10-18, and 20-33 are rejected under 35 U.S.C. § 102(e) as being anticipated by Katz.

### ISSUES

Regarding the first ¶, § 112 rejection, the issue is whether the Specification's teaching of creating a "license *having* a cardinality" (e.g., Specification 11:10-11) provides adequate written descriptive support for "creating a first license *comprising* a first cardinality" (claims 1, 11, 21, and 31). Emphasis added.

Regarding the § 102 rejection, the issue is whether Katz describes, expressly or inherently, "creating a first license comprising a first cardinality" (claims 1, 11, 21, and 31).

### FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

### ANALYSIS

*The rejection of claims 1-8, 10-18, and 20-33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.*

The Examiner takes the position that the Specification provides inadequate written descriptive support for “creating a first license *comprising* a first cardinality” (claims 1, 11, 21, and 31). Emphasis added. Answer 3.

The Appellants disagree, directing attention to various passages in the Specification and original claims which teach creating a license “having” a cardinality. See Specification 11:10-11 (“In operation, license management device 510 creates a license *having* a cardinality.”) Emphasis added. App. Br. 14.

That the Specification does not expressly describe the phrase “creating a first license *comprising* a first cardinality” is undisputed. Accordingly, the question is whether the description in the Specification of “having” a cardinality provides adequate written descriptive support in compliance with ¶1, § 112, for the later-claimed “comprising” a cardinality.

In that regard, we observe that the original claims provided for a license “having” a cardinality.

The transition “having” can also make a claim open. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1573, 43 USPQ2d 1398, 1410 (Fed. Cir. 1997). However, the term “having” does not convey the open-ended meaning as strongly as “comprising.” “Having,” for instance, does not create a presumption that the body of the claim is open. Therefore, this court examines the claim in its full context to determine whether Crystal's use of “having” limits claim 1 to its recited elements.

*Crystal Semiconductor Corp. v. TriTech Microelectronics Int'l Inc.*, 246 F.3d 1336, 1348 (Fed. Cir. 2001). See also *Lampi Corp. v. American Power*

*Prods. Inc.*, 228 F.3d 1365, 1376 (Fed. Cir. 2000) (“Transitional phrases such as ... ‘having’ ... must be interpreted in light of the specification to determine whether open or closed language is intended.”)

The original claims did not limit the term “having” to a closed meaning. Furthermore, in light of the Specification and knowledge in the art at the time of filing, one of ordinary skill in the art would understand a license to include information necessary to permit one to perform an operation to obtain the particular digital content to which the license is directed. For that reason, one can “request a license to *authorize* a playback device he or she owns for playback of specified digital content.” Specification 11:13-14. Emphasis added. And, for that reason, licenses are provided with “commands to the playback devices to which the licenses are targeted.” Specification 12:10-11. Furthermore, the “cardinality,” as defined in the Specification, merely authorizes the number of people which may play digital content. Specification 12:16-13:8. This information alone would not give one access to the digital content, defeating the very goal of requiring a license for access the content.

Accordingly, we find that, in light of the Specification and given the common understanding of the purpose of licenses for digital content and what they would need to accomplish that purpose, the term “having,” as originally disclosed, was not intended to mean the license is closed to the cardinality.

To satisfy the written description requirement, the disclosure as originally filed must reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter. It is a question of

fact. In light of our interpretation that the originally disclosed term “having” was not intended to close the license to the cardinality, we find that a prima facie case that the Specification as originally filed does not reasonably convey to the artisan that the inventor had possession at that time of “creating a first license *comprising* a first cardinality” has not been established.

*The rejection of claims 1-8, 10-18, and 20-33 under 35 U.S.C. § 102(e) as being anticipated by Katz.*

“A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps. First, the Board must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, our review of the Board’s claim construction is limited to determining whether it was reasonable. *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997). Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that “each and every limitation is found either expressly or inherently in [that] single prior art reference.” *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).” *In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

The Examiner has argued that Katz describes “licenses having cardinality associated with the license.” Answer 4. Emphasis original. As the Appellants disagree, pointing out that the claims specify “a license comprising a cardinality.” App. Br. 17.

We construe the claims as one would plainly read them, which is that they require “a license comprising a cardinality.”

The Examiner has cited col. 12, ll. 39-67, of Katz as describing “licenses having cardinality associated with the license.” Answer 4. We have reviewed the passage. It describes a targeting protocol whereby mobile playback devices are grouped together using a Group ID. This ID is stored in the device and used to identify the devices to which data is to be targeted. We do not find there any description, express or inherent, of “a license comprising a cardinality” as claimed. As claimed, the “cardinality indicates the number of playback devices that can be authorized for playback of associated digital audio content.” Claim 1. A “cardinality [that] indicates the number of playback devices that can be authorized for playback of associated digital audio content” (claim 1) does not read on Katz’s Group ID for identifying devices. “Assuming that a reference is properly “prior art,” it is only necessary that the claims under attack, as construed by the court, “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or “fully met” by it.” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983). In this case the claims do not read on Katz as the Examiner has asserted.

#### CONCLUSIONS

The rejection of claims 1-8, 10-18, and 20-33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is reversed.



The rejection of claims 1-8, 10-18, and 20-33 under 35 U.S.C. §102(e) as being anticipated by Katz is reversed.

DECISION

The decision of the Examiner to reject claims 1-8, 10-18, and 20-33 is reversed.

REVERSED

JRG